

## REMARKS

Reexamination and reconsideration of the application are requested.

The examiner's rejection of claims 16-26 as being "obvious", under 35 U.S.C. 103, is respectfully traversed. The examiner rejects these claims as being unpatentable over Keil (US 6,382,372) in view of Wulff (US 5,632,361). Claims 17-18 depend from claim 16 and claims 20-25 depend from claim 19. Independent claims 16, 19 and 26 require that the inner tube 12 have a sidewall and that the entire sidewall be imperforate.

The examiner alleges that Keil provides a non-MR (magnetorheological) twin-tube damper having a non-MR piston, an inner tube wherein the entire sidewall of the inner tube 30 is an imperforate sidewall, an outer tube in fluid communication with the inner tube, and a valve, the valve providing fluid communication between the tubes. Applicants respectfully disagree. Keil does not teach, suggest or describe that the entire sidewall of the inner tube 30 is an imperforate sidewall. The inner tube 30 of Keil is only shown in figures 2 and 3, and figures 2 and 3 taken alone or together do not show the entire sidewall of the inner tube 30 as some of the inner tube 30 is covered by the outer tube 36. One of the regions of the inner tube 30 of Keil not shown in figures 2 and 3 is the upper region. It is noted that the upper region of the inner tube 202 (Wulff calls it a pressure pipe) of an MR twin-tube damper of Wulff is shown in Figure 10 with an orifice 210 (see column 6, line 47) in the sidewall of the inner tube in the very area of the inner tube which is not shown in Keil.

Applicants note that the examiner, in a previous office action, took the position that, "If there was an orifice the inventor would have depicted it in the figure". The examiner took that position even though the examiner, in such previous office action, cited the Jensen patent (US 5,333,708) in rejecting claim 15 (now canceled), wherein column 2, lines 49-51 of Jensen states, "... fluid communication is provided between a chamber 46 below the cylinder end 44 and the reservoir 40", and wherein no figure in Jensen shows any orifice providing fluid communication between the chamber 46 and the reservoir 40.

The examiner also alleges it would have been obvious to have provided Keil with the MR piston of Wulff. The examiner is using the Keil teaching of a twin-tube non-MR damper and the Wulff teaching of a twin-tube MR damper. Applicants' claims are to a twin-tube MR damper.

There is no teaching, suggestion, or description in Wulff that, for example, the orifice 210 in the sidewall of the inner tube 202 is optional in Wulff. The teaching in Wulff is at least a teaching of a twin-tube MR damper with an MR piston in combination with an inner tube having a hole in the sidewall of the inner tube. Keil and Wulff alone or together do not teach, suggest or describe replacing the non-MR piston of Keil with the MR piston of Wulff without also making sure that the hole in the sidewall of the inner tube of Wulff is also present in the sidewall of the inner tube of Keil.

It is noted that the Wulff teaching of a twin-tube MR damper also includes a teaching of an MR fluid (see column 3, line 56), and the Keil teaching of a twin-tube non-MR damper also includes a teaching of a hydraulic fluid / oil (see column 2, line 53 and column 5, line 53).

Surely the examiner is not saying the Keil and Wulff patents teach replacing the non-MR piston of Keil with the MR piston of Wulff without also replacing the non-MR hydraulic fluid / oil of Keil with the MR fluid of Wulff (it is noted that applicants' claims 19-25 also require an MR fluid). Likewise, it is applicants' position the examiner cannot replace the non-MR piston of Keil with the MR piston of Wulff without also making sure that the hole in the sidewall of the inner tube of Wulff is also present in the sidewall of the inner tube of Keil.

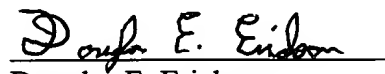
Applicants argue that the examiner has failed to show, from a proper combination of the prior art, an MR damper having an inner tube, an outer tube, and a valve providing fluid communication of the outer tube with the inner tube, wherein the entire sidewall of the inner tube is imperforate, as required by applicants' claims 16, 19 and 26 (from which all of applicants' other claims depend).

It is clear that the patents cited by the examiner, taken alone or in combination, do not teach, suggest, or describe the subject matter of applicants' claimed invention.

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Attorney Docket No.: DP-304351  
Amendment

Inasmuch as each of the rejections has been answered by the above remarks, it is respectfully requested that the rejections be withdrawn, and that this application be passed to issue.

Respectfully submitted,

A handwritten signature in cursive script, reading "Douglas E. Erickson", written over a horizontal line.

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